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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,071	08/26/2003	Donald C. Roe	7193CDQ	3375

27752 7590 06/29/2005

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,071

Applicant(s)

ROE ET AL.

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-22, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-22, 38, 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/4/05 have been fully considered but they are not persuasive.
2. In response to applicant's argument that Yahiaoui, Roe, Wellinghoff, and Butterworth does not teach the claimed effect on the Hardness of feces, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As to the teaching of the agents in claim 2, alkyl glycosides are functionally equivalent to phenols. For example Cassidy et al. USPN 5567359 teaches alkyl glycosides, betaines and phenols as surfactants (col. 6, lines 6-35).

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Claims 16 and 17 disclose the agent is releasably attached to a portion of the article. In this case, Wellinghoff is relied on to teach an attachment means of a fecal modifying agent to a hydrophilic component comprising hydrogen bonding.

As to the Wellinghoff reference, applicant argues Wellinghoff does not disclose that the invention can be a diaper as asserted by the Office. Wellinghoff explicitly discloses in col. 27, line 44-45 the treated surface can be an absorbent layer for use in diapers. As to whether the article itself can be used as a diaper, the argument is directed to an intended use of the product and does not structurally define the claimed invention over the prior art.

4. In response to applicant's argument that Butterworth does not teach a brush structure which includes feces modifying agents, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

5. In response to applicant's argument that Al-Sabah fails to teach or suggest that the audio indicating means is adaptable or capable of delivering a feces modifying agent as recited, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it

that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-22 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth the physical characteristics desired of the composite alone rather than the specific composition of the composite in the end product. Therefore, relying on *Ex parte Slob*, 157 USPQ 172, such claims could cover any conceivable combination of materials whether presently existing or which might be discovered in the future and which would impart the desired characteristic, i.e. the claims are too broad and indefinite since they purport to cover everything having the claimed characteristics regardless of its composition (It should be noted that 35 USC 101 sets forth "Whoever invents or discovers any new and useful...composition of matter...may obtain a patent therefor...title, i.e. does not include composition that have yet to be invented and discovered.).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(s) of such treaty in the English language.

9. Claims 1, 3-7, 10, 11, 14, 18, and 39, as best understood by the examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Yahiaoui et al. USPN 6060636.

As to claims 1, 3, and 39, Yahiaoui discloses an absorbent article adapted to be applied to a wearer's perineal region for receiving feces, the article comprising: a substrate; a means for holding the substrate in contact with the wearer perineal region; and is adapted to receive feces having a first waist region, a second waist region opposed to the first waist region, a crotch region disposed between the first waist region and the second waist region (col. 2, lines 35-44, and col. 8, lines 24-27, where Yahiaoui discloses the invention can be a diaper which is known to have first and second waist regions), the absorbent article comprising: a liquid pervious topsheet; a liquid impervious backsheet joined to at least a portion of the topsheet; an absorbent core disposed between at least a portion of the topsheet and the backsheet (col. 15, lines 24-33), and an effective amount of a feces modifying agent, which decreases the viscosity of the feces (hence, it is interpreted that the agent acts as a reducing agent),

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disposed in the article such that the reducing agent is available to contact at least a portion of the feces deposited in the article (col. 2, lines 35-57; col. 5, lines 27-35; col. 10, lines 31-52; col. 14, lines 41-58; and col. 15, lines 24-33).

The Hardness value is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 4, 6, and 10, Yahiaoui discloses the reducing agent decreases the Hardness of the feces reduction by at least about 25% at a concentration of about 0.1-5%, which includes the ranges of 0.1%, no more than about 0.5 weight percent, no more than about 1.5 weight percent, and no more than 5 weight percent (Abstract and col. 5, lines 27-35).

As to claims 5 and 7, Yahiaoui discloses the change in viscoelastic properties of the insulted fluid occurs on contact, which includes the range of no more than about 5 minutes (col. 2, lines 53-59).

As to claims 11 and 14, the absorbent article of claim 1 wherein the reducing agent is disposed on a carrier structure (col. 2, lines 44-53).

As to claim 18, Yahiaoui discloses the absorbent article of claim further includes at least one three-dimensional structure joined to or extending from an element of the absorbent article, the three-dimensional structure comprising the reducing agent, wherein the three-dimensional structure promotes contact between the reducing agent and the feces (col. 2, lines 50-61).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yahiaoui in view of Cassidy et al. USPN 5567359. Yahiaoui discloses the claimed invention except that Yahiaoui teaches alkyl polyglycoside. Alkyl glycosides are functionally equivalent to phenols. For example Cassidy et al. USPN 5567359 teaches alkyl glycosides, betaines and phenols as surfactants (col. 6, lines 6-35). Therefore, because these two are art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute alkyl glycoside for phenols or betaines.

13. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahiaoui in view of Roe USPN 5643588. Yahiaoui discloses the present invention substantially as claimed. However, Yahiaoui fails to disclose the carrier structure includes a skin care composition. Roe discloses an absorbent article comprising a skin care composition on the topsheet for the benefits of imparting a therapeutic or protective lotion to the wearer (Abstract). It would have been obvious to one having ordinary skill in the art to incorporate a skin care composition in the invention of Yahiaoui for the benefits taught in Roe.

As to claim 13, Yahiaoui/Roe discloses the skin care composition includes

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components selected from the following group: petroleum oils, petroleum waxes, silicone oils and silicone waxes (Roe Abstract, col. 10, line 37 through col. 12, line 67).

14. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahiaoui in view Wellinghoff et al. USPN 6046243. Yahiaoui discloses the present invention substantially as claimed. However, Yahiaoui does not disclose the reducing agent is releasably attached to at least a portion of the article. Wellinghoff discloses an absorbent material treated with a fecal modifying agent that is releasably attached to at least a portion of the article by hydrogen bonding so as not to react with the released gas (col. 8, lines 46-54; col. 23, lines 9-10; col. 27, lines 35-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the reducing agent of Yahiaoui to be releasably attached for the benefits taught in Wellinghoff.

15. Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yahiaoui in view of Butterworth et al. USPN 4077410. Yahiaoui discloses the present invention substantially as claimed. However, Yahiaoui fails to disclose the carrier structure includes a brush structure or printed hairs. Butterworth discloses an absorbent article having a brushed surface or printed hairs for the benefit of providing a soft, fibrous outer surface (Butterworth col. 3, lines 16-27 and col. 4, lines 27-43). It would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify the surface sheet of Yahiaoui to have a brushed surface or printed hairs for the benefits taught in Butterworth.

16. Claims 1-3, 20-22, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellinghoff et al. USPN 6046243.

As to claims 1-3, and 39, Wellinghoff discloses an absorbent article adapted to be applied to a wearer's perineal region for receiving feces, the article comprising: a substrate; a means for holding the substrate in contact with the wearer perineal region; receive feces having a first waist region, a second waist region opposed to the first waist region, a crotch region disposed between the first waist region and the second waist region (col. 27, lines 4-45, where Wellinghoff discloses the invention can be a diaper which is known to have first and second waist regions). Wellinghoff does not disclose the absorbent article comprising: a liquid pervious topsheet; a liquid impervious backsheet joined to at least a portion of the topsheet; an absorbent core disposed between at least a portion of the topsheet and the backsheet. However, it is old and well known in the art to provide a diaper with a topsheet, backsheet, and absorbent core as claimed.

Wellinghoff further discloses an effective amount of a reducing agent, which decreases the viscosity of the feces, disposed in the article such that the reducing agent is available to contact at least a portion of the feces deposited in the article (col. 9, lines 42-50; col. 27, lines 42-44), wherein the reducing agent is selected from the group consisting of sulfites, thiols, alcohols, mercaptoacetic acid, sodium thioglycolate,

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thiolactic acid, thioglycoamide, glycerol monothioglycolate, borohydrides, tertiary amines, thiocyanates, thiosulfates, cyanides, thiophosphates, arsenites, phosphines, betaines, hydroxylamine, and $\text{LiHB}(\text{C}_2\text{H}_5)_3$ (col. 11, lines 54-60).

The Hardness value is determined by performing a test set forth in the application. Therefore the claims also define the invention by processes of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 21, Wellinghoff discloses comprising a gas evolving system including at least one composition which evolves gas when mixed with water, wherein the gas evolving system delivers the reducing agent to the feces (Abstract, col. 8, lines 3-6; col. 9, lines 1-7; col. 9, lines 41-50).

As to claims 20 and 22, Wellinghoff discloses a gas evolving system including a water soluble material containing compressed gas which evolves when mixed with water, wherein the gas evolving system delivers the reducing agent to the feces and the reducing agent is disposed adjacent a water soluble film (col. 39, lines 29-62).

17. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yahiaoui in view of Al-Sabah USPN 5868723. In reference to the structure of the waist regions, crotch region, topsheet, backsheet, and absorbent core Yahiaoui discloses the present invention substantially as claimed (see 102 rejection of claim 1). However, Yahiaoui does not disclose a responsive system including a sensor operatively connected to the article. Al-Sabah discloses an absorbent article comprising an acoustic transducer **29** and an actuator **43**, which comprises a power source 42 (Figure 7). The actuator performs a responsive function when the sensor detects an input (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Yahiaoui to incorporate a sensor as taught in Al-Sabah. Doing so would provide a means for alerting the user or a health care professional of the presence of the waste material.

The invention of Yahiaoui/ Al-Sabah provides a sensor adapted to detect an input, and an actuator operatively connected to the article, the actuator being adapted to deliver an effective amount of a reducing agent to the feces when the sensor detects the input.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacqueline F Stephens
Examiner
Art Unit 3761

June 24, 2005